

### Remarks

Claims 1-3 and 5-15 are pending in this Application. Claims 4 and 16 have been previously canceled without prejudice. Claims 2, 3 and 7-11 have been withdrawn. In the final Office Action mailed June 16, 2007, the Examiner:

- provisionally rejected Claims 1, 5, 6 and 12-15 on grounds of obviousness-type double patenting (ODP) over copending Application Publication Nos. 2004/0081827 and 2004/0079260;
- rejected Claims 1, 5, 6 and 12-15 under 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 3,365,315 (herein "Beck") or U.S. Patent No. 4,983,550 (herein "Goetz").

Applicants respectfully address herein the basis for each of the Examiner's rejections.

#### ***Claims Rejections – Nonstatutory Type Double Patenting***

Applicants respectfully traverse the provisional rejection and request that it be held in abeyance until there is allowable subject matter in one of the co-pending applications, at which time an appropriate filing will be provided.

#### ***Claims Rejections - 35 U.S.C. § 102(a) and/or 103(b)***

On page 3 of the Office Action, the Examiner rejected Claims 11, 5, 6 and 12-15 as being anticipated by or, in the alternative, obvious over Beck or Goetz. Applicants submit that neither Beck nor Goetz anticipate Applicants' claimed invention because neither reference teaches each and every element of the claimed subject matter. Beck is said to disclose  $R_2O_3$  (satisfied preferably by  $B_2O_3$ ) in a range of 0 to 20 wt.% in its *precursor* (glass former) composition. Commercial soda-lime-silica is stated to be successful for preparing microspheres; additional examples used to provide real evidence show that when making actual microspheres, the content of alumina oxide in the *precursor* is only 1.2 wt.% (Examples 1 and 5) or 1.8 wt.% when combined with iron oxide (Example 4). Beck does not actually state the final composition of its microspheres. Applicants

have amended Claim 1 to include microspheres with 30-59 wt.% silica oxide, which is within Applicants' claimed range (see Microsphere A of Example 8) and is not anticipated by Beck because Beck teaches a different range of silica oxide and, thus, does not teach each and every element of Applicant's claimed invention. Furthermore, Beck is not obvious over Applicants' claimed invention, because Beck purposefully dictates a high silica oxide content and states that the microspheres are made by incorporating gas forming materials within the precursor pre-formed glass particles, the materials that include H<sub>2</sub>O, CO<sub>2</sub>, SO<sub>2</sub> or F<sub>2</sub> (Col. 5, ll. 25-32). This means that the microspheres produced therefrom will include a higher oxides content than provided in the precursor (e.g., greater than the 60-80 wt.% of SO<sub>2</sub>). Beck further states that soda-lime-silica is provided successfully as the pre-formed glass particles (Col. 4, ll. 17-25). No other glass formers are clearly represented. And Beck never actually states the composition of the final microspheres. Applicants point out that if one skilled in the art cannot readily anticipate the effect within the subject matter of the reference to which the claimed invention is compared, then there is lack of predictability in the reference. Predictability requires that one of ordinary skill can readily extract the information in Beck to include all its various and realistic teachings. Beck realistically teaches a precursor formulation and representative examples therefrom obtained from soda-lime-silica. Since the reference is only as good as its teachings, Beck cannot be obvious over Applicants' claimed invention because Beck teaches a different precursor composition that provides a different final composition; neither expressly or inherently does Beck teach a silica oxide content of 30-59 wt.% in its final microspheres. In addition, Beck provides no motivation or reason to make any changes to its invention to arrive at Applicants' claimed invention in which, for example, the silica oxide content is 30-59 wt.%. One of ordinary skill in the art would not look to Beck to provide Applicants' claimed invention due to the divergent teachings. Accordingly, Beck does not teach each and every element of Applicants' claimed invention and there is no motivation or suggestion by the reference or to one of ordinary skill to make anything but the realistic teachings provided by Beck. Without any motivation, there is no expectation of success. Applicants submit that Beck does not anticipate and is not obvious over the claims provided herewith.

With regard to Goetz, this reference also does not anticipate Applicants' claimed invention because Goetz does not teach each and every element of Applicants' claims. Applicants have amended Claim 1 to include less than 2 wt.% potassium oxide, while Goetz does not teach less than 2 wt.% potassium oxide. Accordingly, Goetz does not teach each and every element of Applicants' claimed invention and cannot anticipate the claims. Goetz is also not obvious over Applicants' claimed invention because Goetz has a very specific teachings of microspheres with, among other things, a higher potassium oxide that is *not* less than 2 wt.% potassium oxide. Goetz, therefore, teaches a very different microsphere than Applicants' claimed microspheres. The very specific microsphere teaching of Goetz could not simply be modified or rearranged by itself or by one of ordinary skill in the art because the Goetz reference does not itself provide any motivation or reason for any modifications other than the specific teachings within Goetz that are different from Applicants' claimed invention. One skilled in the art cannot simply extrapolate these specifically disclosed teachings and the embodiments of Goetz to cover Applicants' claimed invention because there is no way to readily anticipate the effect of a change within the subject matter of Goetz based on Goetz's own disclosure. Accordingly, Goetz is not obvious over Applicants' claimed invention. Applicants respectfully request removal of the rejections and entry and allowance of the claims as provided herein.

### **Conclusion**

Applicants respectfully submit that the Application for patent is in condition for allowance, and pursuant to the filing of this Amendment, Applicants earnestly seek allowance of the claims, as provided in the Listing of Claims beginning on page 3 of this paper. Should the Examiner have questions, comments, or suggestions in furtherance of the prosecution of this Application, please contact Applicants' representative at 214-999-4330. Applicants, through their representative, stand ready to conduct a telephone interview with the Examiner to review this Application if the Examiner believes that such an interview would assist in the advancement of this Application.

This paper is submitted concurrently with a Request for Continued Examination and the appropriate fees. To the extent that any further fees are required during the pendency of this Application, including petition fees, the Commissioner is hereby authorized to charge payment of any additional fees, including, without limitation, any fees under 37 C.F.R. § 1.16 or 37 C.F.R. § 1.17, to Deposit Account No. 07-0153 of Gardere Wynne Sewell LLP and reference Attorney Docket No. 129843-1104.

In the event that any additional time is needed for this filing, or any additional time in excess of that requested in a petition for an extension of time, please consider this a petition for an extension of time for any needed extension of time pursuant to 37 C.F.R. § 1.136 or any other section or provision of Title 37. Applicants respectfully request that the Commissioner grant any such petition and authorize the Commissioner to charge the Deposit Account referenced above. Please credit any overpayments to this same Deposit Account.

This is intended to be a complete response to the Office Action made final, mailed on June 18, 2007.

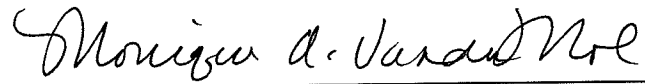
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AMENDMENT AND RCE  
Application No. 10/648,009

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**Please direct all correspondence to the practitioner listed below at Customer No. 60148.**

Respectfully submitted,



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